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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,970	09/24/2003	Walter Rosenbaum	2001P015313WOUS	1456

28204 7590 07/07/2004

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EXAMINER

WEBB, JAMISUE A

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 07/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



Office Action Summary

Application No.

10/668,970

Applicant(s)

ROSENBAUM ET AL.

Examiner

Jamisia A. Webb

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 20040120.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. With respect to Claim 1: the phrase "the information comprises... and means for triggering a process..." is indefinite. It is unclear how information (an abstract concept) can comprise a physical thing, i.e. means for.
4. With respect to Claim 1: the phrase "after acceptance of the charge payment process, reported delivery the franking number comprising" is indefinite. First of all the claim has not previously recited an acceptance step, so it is unclear what this phrase is referring to. Second, this phrase is grammatically incorrect and it is unclear what the phrase "reported delivery" is referring to, who is reporting the delivery and who is it being reported to, and does this mean reporting information about the delivery?
5. Claim 1 recites the limitation "the charge payment process" in lines 7-8. There is insufficient antecedent basis for this limitation in the claim.
6. With respect to Claim 1: the phrase "reading delivery labels" is indefinite. The claim has not previously generating any delivery labels, therefore it is unclear what delivery labels are being read.

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7. With respect to Claim 1: the phrase “determining and reading recipient address: is indefinite. It is unclear to the examiner what the address is being determined and read from”. Is this from the delivery label?

8. Claim 1 recites the limitation "the franking database". There is insufficient antecedent basis for this limitation in the claim.

9. With respect to Claim 2: the phrase “after the record is located in the database” is indefinite. In claim 1 the record being located is optional, and it allows for the possibility of no record being found. Therefore it is unclear if no record is found, does this step still exist.

10. With respect to Claim 5: the applicant has used the acronym OCR, it is unclear to the examiner what this acronym is standing for, due to the fact the claims have not previously defined this term. The examiner suggest writing out the full phrase for the acronym OCR in the claim.

11. With respect to Claim 7: the phrase “the franking number comprises a defined position” is indefinite. It is unclear to the examiner how a number can comprise a position. A number can be located in a defined position, but a number is only alphanumeric characters, and therefore it is unclear how it can comprise a position (abstract concept).

12. With respect to Claim 8: the phrase “further comprising the step of applying an additional character for characterizing franking with the franking number a location on the delivery which is provided for stamps” is indefinite. This phrase appears to be grammatically incorrect, causing it to be unclear what is actually being claimed. The

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examiner suggest taking extra caution when amending the claims to make sure the claims are definite and form complete sentences.

13. With respect to Claim 12: the phrase "the coded" is indefinite. It is unclear to the examiner the coded "what" this is referring to.

Claim Rejections - 35 USC § 102

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

15. Claims 1, 7-11 and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Kara.

16. With respect to Claim 1: Kara discloses the use of a Method for pricing and processing deliveries (see abstract), transmitting information from customer to carrier (from supplier to carrier) (Column 31, lines 1-8), where the information includes recipient and cost details (Figure 8), Kara discloses applying the shipping label (which includes a delivery number) to the delivery (Column 31, lines 1-8), where this is done by the customer and is in human readable form (Column 12, line 42-48). Kara discloses each of the shipping labels will include a user number as well as a transaction number (column 6, lines 1-6), the examiner considers a transaction number to be a franking number, since it is for each delivery at a certain time to a certain customer. Kara also

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discloses that an invent log with all transactions and shipping information is stored in Figures 12 and 13, as well as the registration database in Figure 14 (see also detailed description on these figures). Kara discloses reading the shipping label and searching the database for records on the particular parcel, and if there are records and they match the parcel is shipped and if the parcel does not match the criteria, then the delivery is rejected (See Column 31, lines 1-51).

17. With respect to Claims 7-9: See Figures 6, 8 and 9.
18. With respect to Claim 10: See Figure 8
19. With respect to Claim 11: See Column 31, line 52 to Column 32, line 13.
20. With respect to Claim 13: See Column 31, lines 1-51.

Claim Rejections - 35 USC § 103

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

22. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

23. Claims 2-4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kara.

24. With respect to Claims 2 and 3: Kara discloses a barcode is applied to the delivery as well as in the human readable form (Column 12, lines 42-65). However, Kara fails to teach the barcode being placed on the delivery after the step of searching the databases and finding a record. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the barcode being placed on the delivery after the database is searched and a record is found, since applicant has not stated any reason or purpose in the specification why the barcode is applied after the records is searched, and it has been held that rearranging of steps involves only routine skill in the art.

25. With respect to Claims 4 and 6: Kara, as disclosed above for Claim 1, fails to disclose determining of there is a valid forwarding address and notifying customer if there is a valid forwarding address. It is old and well known in the art that carriers, such as the post office, keeps records of forwarded addresses, for instance when someone moves, and before any piece of mail is sent out, it is checked to see if there is a forwarding address that is currently valid. The recipient must inform the carrier or post office when such move occurs and the post office will then notify the customers. Therefore it would have been obvious to determine if the delivery has a forwarding address, so that the package is not delivered to the wrong person.

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26. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kara in view of Zlotnick et al. (5,737,438).

27. Kara, as disclosed above for Claim 1, discloses the claimed invention but fails to disclose the use of OCR. Zlotnick et al. (5,737,438) discloses the use of an OCR program to scan and read shipping labels (See abstract, Figure 1, and column 1, lines 37-45) and the label is clarified (which the examiner considers to be corrections) and identify the writing on the label (see Figure 2). It would have been obvious to one having ordinary skill in the art at the time the invention was made, to modify the shipping system of Kara, to include the OCR capability of Zlotnick to read shipping labels, in order to provide an automatic identification of routing information from parcels for subsequent use in easily sorting parcels for delivery (See Zlotnick, columns 1 and 2).

28. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kara in view of Kato et al. (5,971,587).

29. Kara, as disclosed above for Claim 1, discloses that it is common to have tracking of items as an option (column 3, lines 11-23), however fails to disclose the system tracking and monitoring the delivery. Kato discloses a package and mail delivery system where the package labels and tracking numbers can be read at any point along the delivery route (See Kato, abstract). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kara to include the tracking and monitoring, as disclosed by Kato, in order to provide an inexpensive method of tracking a delivery through its entire delivery cycle, not only the beginning and end points. (See Kato, Columns 1 and 2)

Conclusion

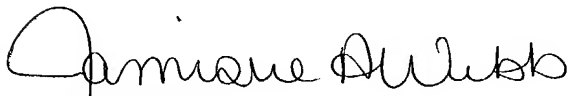
30. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Savino et al. (6,015,167) discloses the use of a system and method which automatically creates and prints a barcode, Kara (5,606,507) discloses the use of a system of printing postage on mail, Hennig et al. (6,587,827) discloses the use of each order assigned a purchase order number, Sharp et al. (6,263,317) discloses the use of a sales conflict web resolution system, Theil (5,699,258) discloses an assembly of a franking machine and system, Fruechtel (6,175,825) discloses the use of debiting shipping services, Guidice et al. (6,463,420) discloses online tracking of deliveries.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamisue A. Webb whose telephone number is (703) 308-8579. The examiner can normally be reached on M-F (7:30 - 4:00).

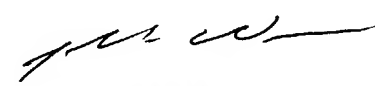
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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